

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on October 4, 2004.

Claims 1-6, 8, 10, 11, 13-30, 32-60, 63-70 and 72-80 are pending in the Application, Claim 79 stands rejected, and Claims 74 and 78 stand as allowable, but objected to because of minor informalities. Claims 1-6, 8, 10, 11, 13-30, 32-60, 63-70, 72-78 and 80 have been allowed. The indication of allowed and allowable subject matter is noted with appreciation. Claims 74, 78, and 79 are amended by the present Amendment.

Summarizing the outstanding Office Action, Claims 74 and 78 were objected to because of informal issues. Claim 79 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Holzhauser (U.S. Patent No. 4,593,995, hereinafter "Holzhauser") in view of Miyakawa et al. (U.S. Patent No. 5,247,334, hereinafter "Miyakawa").

Applicants thank the Examiner for the courtesy of an interview extended to Applicants' representative on November 5, 2004. During the interview, arguments as hereinafter developed were presented to discuss the outstanding obviousness rejection of Claim 79. Applicants' representative argued that the motivation to combine Holzhauser and Miyakawa was not support by "substantial evidence" within the record,¹ and by "clear and particular" evidence² of a suggestion or motivation to combine the teachings of both references. As discussed during the interview, there is no substantial evidence, nor clear and

¹ In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

² In re Dembiczkak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.")) (emphasis added).

particular evidence, within the record of a motivation for modifying the Holzhauser's device by incorporating therein the wet-type development of Miyakawa. It was further argued that, without such motivation and absent improper hindsight reconstruction,³ a person of ordinary skill in the art would not be motivated to perform the proposed modification.

During the interview it was also argued that, even if assuming *in arguendo* that there is a motivation to combine both references, the resulting combination of Holzhauser and Miyakawa did not teach or disclose the transferring of first and second images from the image supporting member to a recording medium without fixing the first image in the recording medium before transferring the second image to the recording medium. This is so because Miyakawa discloses the fixing of the image before each transfer.

Although an agreement was not reached on the lack of motivation to combine, an agreement was reached on the failure of Miyakawa to teach or disclose the transferring of first and second images without applying fixing between transfers. The Examiner, Ms. Susan S. Lee, indicated on the interview summary (form PTOL-413) that "Mr. McQuay discussed differences where fixing is not performed or is not needed between the first and second transfer units. This is not shown in Miyakawa."

Claim 79 is amended to recite an image formation device, comprising, among other features, first and second transfer units to transfer an image formed on the same image supporting to a recording medium, wherein an image fixing is not performed between when a first image transferred to the image supporting member by the first transfer unit is transferred to the recording medium and when a second image transferred to the image supporting member by the second transfer unit is transferred to the recording medium. Non-limiting support for the subject matter amended to Claim 79 is found in Applicants' Specification, on page 62, lines 11-22.

³ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

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Based at least on the agreement reached during the personal interview and the instant amendment to Claim 79, Applicants respectfully submit that the above-summarized obviousness rejection of Claim 79 is now moot. Its withdrawal is respectfully requested.

As to the objection to Claims 74 and 78, Applicants have amended Claims 74 and 78, including correction of the cited informalities, and respectfully request reconsideration of the objection thereto. If, however, the Examiner disagrees, he is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-6, 8, 10, 11, 13-30, 32-60, 63-70 and 72-80 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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